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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/017,695	12/14/2001	Folker Lieb	Bayer 9962.3-HCL/100717-5	7725

7590

09/17/2003

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EXAMINER

TRUONG, TAMTHOM NGO

ART UNIT

PAPER NUMBER

1624

DATE MAILED: 09/17/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Applicati n No.

10/017,695

Applicant(s)

LIEB ET AL.

Examiner

Tamthom N. Truong

Art Unit

1624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 12-14-01 (Prelim. Amst.)
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-5, and 22-26 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5, and 22-26 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☒ Certified copies of the priority documents have been received in Application No. 08/945,664.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 3. 6) ☐ Other: \_\_\_\_\_

### DETAILED ACTION

Applicant's preliminary amendment of 12-14-01 has been entered. Claims 6-21 have been cancelled. Thus, only claims 1-5 remains for consideration along with new claims 22-26.

#### *Claim Rejections - 35 USC § 112*

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

1. Claims 1-5, and 22-26 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The following reasons apply:

- a. Claims 1-5 recites limitations of "D", "A and D" which do not seem to bear a relationship to formulae (1) and (3). Deletion of said limitations is suggested.
- b. Claims 2-4 recites variables  $R^{23} - R^{20}$ , which are related to "A and D", but not to formulae (1) and (3). Deletion of said variables is suggested.
- c. Claim 2 also lacks antecedent basis for reciting "hetaryl-C<sub>1</sub>-C<sub>6</sub>-alkyl" in the definition of R<sup>1</sup>, which is not recited in claim 1. In claim 1, the definition of R<sup>1</sup> includes "hetaryloxyalkyl", which is not the same as "hetaryl-C<sub>1</sub>-C<sub>6</sub>-alkyl".
- d. Claim 5 recites processes (A), (B), and (E) – (M) which are directed the processes of making compounds of other (non-elected) groups. Deletion of said processes is suggested.

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e. In claim 1, the word "Compounds" is in plural form, and reads on mixtures.

Accordingly, changing said word to "A compound" would overcome the rejection.

### ***Double Patenting***

The **nonstatutory double patenting** rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 1-4, and 24-26 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 2, 10 and 11 of U.S. Patent No. 6,380,246. Although the conflicting claims are not identical, they are not patentably distinct from each other because the instant formula I overlaps with the formula I of US'246 having the following substituents:

- a. X, Y, and Z have the same definitions as those recited in the instant claim 1;
- b. Het represents formula (3), which is a thiophenone;
- c. A, B and G have the same definitions as those recited in the instant claim 1;
- d.  $R^1$ ,  $R^2$ ,  $R^4$ - $R^7$  basically have the same scope as those recited in the instant claim 1;

- e.  $R^3$  is optionally substituted alkyl, phenyl or benzyl.

Claims 10 and 11 of US'246 overlaps with the instant claims 24-26 because they all recite method of combating pests and weeds as well as a process of preparing a pesticidal or herbicidal composition. The instant formula I differs from the one of US'246 by **not** having Het as other heterocycles represented by formulae (1), (2), (4)-(6) recited in claim 1 of US'246. However, the instant formula I allows  $R^3$  to also be alkylamino, dialkylamino, alkylthio, alkenylthio, or cycloalkylthio, each of which is optionally substituted by halogen.

3. Claims 1-4, and 22-25 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-5, 10 and 11 of U.S. Patent No. 5,945,444. Although the conflicting claims are not identical, they are not patentably distinct from each other because the instant formula I overlaps with the formula I of US'444, having the following substituents:

- a. X represents a halogen;
- b. Y and Z, independently represents an alkyl group or a halogen;
- c. A and B together with the carbon atom, to which they are bonded, form a saturated carbocycle;
- d. G represents (a) hydrogen, (b)  $-C(=O)R^1$ , (c)  $-C(=L)-M-R^2$ .

The instant formula I differs from the one of US'444 by **not** having X as an alkyl, alkoxy or halogenoalkyl group as well as **not** having Y, or Z as hydrogen, alkoxy, or halogenoalkyl groups. However, the instant formula I allows G to also be  $-SO_2-R^3$ ,  $-P(=L)-R^4R^5$ , E (metal ion equivalent, or ammonium ion),  $-C(=L)-NR^6R^7$ .

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4. Claims 1-4, and 22-25 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 4, 7, and 8 of U.S. Patent No. 5,262,383. Although the conflicting claims are not identical, they are not patentably distinct from each other because the instant formula I overlaps with the formula I of US'383 having the following substituents:

- a. D represents sulphur;
- b. X represents halogen;
- c. Y and Z, independently represents an alkyl group, or a halogen;
- d. A, B, G and other variables practically have the same scope.
- e.  $R^1$ , and  $R^3-R^7$  basically have the same scope as those claimed herein.
- f.  $R^2$  is optionally substituted alkyl, alkenyl, alkoxyalkyl, polyalkoxyalkyl, phenyl, or benzyl.

The instant formula I differs from the one of US'383 by **not** having a furanone ring (i.e., D in US'383 as oxygen) as well as **not** having X, Y and Z represent other groups (i.e., hydrogen, alkoxy, halogenoalkyl). However, the instant formula I also allows  $R^2$  to be an optionally substituted cycloalkyl group.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tamthom N. Truong whose telephone number is 703-305-4485. The examiner can normally be reached on M-F (5:00-12:30) & every Saturday morning (starting from 4-7-03).

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mukund Shah can be reached on 703-308-4716. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-4556 for regular communications and 703-308-4556 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1235.



T. Truong

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September 16, 2003